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HM12/0420

EXAMINER
STOCKTON, LART UNIT
1626

PAPER NUMBER

DATE MAILED:

04/20/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____☐ This action is FINAL.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), ~~this date~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-24 and 27-43 are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-24 and 27-43 are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☒ received in Application No. (Series Code/Serial Number) 08/824,715
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 5 and 6
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

08/678218

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DETAILED ACTION

Claims 1-24 and 27-43 are pending in the application.

Reissue Applications

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: the reissue oath/declaration does not comply with all of the requirements of 37 CFR §1.63 in that the foreign priority data is missing.
2. Claims 1-24 and 27-43 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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3. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

4. The amendment to the claims are in compliance. However, any future amendments to the claims must comply with the new rules as set forth in 37 CFR 1.173.

5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

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Claims 1-24 and 27-43 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Priority

6. Receipt is acknowledged of papers filed under 35 U.S.C. 119 (a)-(d), in parent application 08/824,775, based on an application filed in Japan on April 5, 1996. Applicant has not complied with the requirements of 37 CFR 1.63(c), since the oath or declaration

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does not acknowledge the filing of any foreign application. A new oath or declaration is required in the body of which the present application should be identified by application number and filing date.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 36, there is no antecedent basis from claim 1 for R² representing a methyl or amino group. It would appear that the first R² in claim 36 should be R¹.

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Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 1-15, 27-29 and 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Khanna et al. {U.S. Pat. 5,935,990}.

Khanna et al. disclose 4-[2-(4-fluorophenyl)-1H-pyrrol-1-yl]benzenesulfonamide {CA Registry Number 189501-09-5} which is embraced by the instant claims (column 3, lines 44-67, column 4, lines 1-25 and column 8, line 11).

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Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-24, 27-30 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khanna et al. {U.S. Pat. 5,935,990}.

Applicants claim pyrrole compounds.

Determination of the scope and content of the prior art (MPEP §2141.01)

Khanna et al. teach pyrrole compounds which are structurally the same (see 102 rejection above) or structurally similar to the instant claimed compounds (column 3, lines 1-43 and column 7, lines 21-47).

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that of generic description.

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Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 1-1 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (ie., an anti-inflammatory).

One skilled in the art would thus be motivated to prepare pyrrole compounds embraced by the reference to arrive at the instant claimed pyrrole compounds with the expectation of obtaining additional beneficial pyrrole compounds which would be useful in treating inflammation.

Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

13. Applicant cannot rely upon the foreign priority papers to overcome the rejection of the claims under 35 U.S.C. §102(e) and 35 U.S.C. §103 because a translation of said papers has not been made of record in

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accordance with 37 CFR 1.55 (see MPEP § 201.15) nor has Applicant complied with the requirements of 37 CFR 1.63(C) as stated above.

14. In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents **must** be submitted in response to this Office action.

Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, which will be strictly enforced.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton, Ph.D. whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1335.

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A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.



Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

April 20, 2001